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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,846	03/21/2001	Tadaatsu Nagumo	1614.1141	1451

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EXAMINER

BARQADLE, YASIN M

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/812,846	NAGUMO, TADAATSU	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yasin M. Barqadle	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 05, 2006 has been entered.

**Response to Amendment**

The amendment filed on September 05, 2006 has been fully considered but are not deemed persuasive.

- Claims 1-21 are presented for examination.
- Claim 22 is withdrawn from consideration.

**Response to arguments**

The Applicant in essence argues that Powlette does not disclosed or suggested "a processing apparatus for generating an executable file, comprising a data generating part generating a data part by analyzing an input print job formed by a set of

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commands." (Pages 10-11 of the remarks). Examiner notes that Powlette teaches (...a user is prompted to determine if they would like to capture and preserve the modified window image data, i.e. such as by printing in a hard copy form (col. 4, lines 32-40 and col. 9, lines 2-34 and col. 10, lines 18-30. Powlette, further teaches ("Because such file is also retrieved in a format usable by browser 160, it can be manipulated and treated like any other file so that, for example, at step 270 it can now be saved in electronic form on local storage device 130, or printed on a local output device 135" col. 3, lines 26-31; col. 10, lines 18-30 and col. 11, lines 25-31). An input print job includes print command performed on the manipulated and modified captured file. Hence implying the processing of the generated file. Powlette further teaches that the modified data file 166 is then displayed in a graphics image format in a separate window 350 where it can be printed to out put device 135, fig.1 (col. 11, lines 25-31). Printing original captured image implies generating print data to be printed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,3,79,1316, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. " a data generating part generating a data part by analyzing an input print job formed by set of commands." The specification as originally filed does not show generating a data part by analyzing an input print job formed by set of commands. The specification mentions specified commands indicating to print a displayed data content page 20, lines 1-10 "If the content of the specified command indicates print, a step A56 carries out a print process to print the displayed data contents by the existing printer such as the printer 24. This print process may be carried out by specifying a printer driver corresponding to the existing printer using a known print dialog." This is not similar generating a data part by analyzing an input print job formed by set of commands.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Powlette (U.S. Patent No. 6,489,954).

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As per claim 1, Powlette teaches a processing apparatus for generating an executable file (fig. 1 and abstract), comprising:

a data generating part generating a data part by analyzing an input print job formed by set of commands (generates modified data based on the user's modifying of the initial data, performing annotations via a keyboard/mouse and generating additional data by an applet code in response to a user command from such input device, or some other authorized and accessible data source for the applet...a user is prompted to determine if they would like to capture and preserve the modified window image data, i.e. such as by printing in a hard copy form col. 4, lines 32-40 and col. 9, lines 2-34 and col. 10, lines 18-30) (print commands must be analyzed to perform printing task. In order to print an image file, the right print driver must be loaded); and a file generating part generating the executable file including the data part and a data processing part having the data part as a processing target which are developed depending on an execute instruction (the program data is generally associated with modified file data resulting from modifications made by a user to initial data from an initial data file, including files such as chart data files, an audio file, a video file, a text file col. 3, lines 39-56 and col. 4, lines 11-40);

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said file generating part generating the executable file by including an updating part which updates contents of the executable file using data modified by the developed data processing part ("Because such file is also retrieved in a format usable by browser 160, it can be manipulated and treated like any other file so that, for example, at step 270 it can now be saved in electronic form on local storage device 130, or printed on a local output device 135" col. 3, lines 26-31; col. 10, lines 18-30 and col. 11, lines 25-31).

As per claim 2, Powlette teaches the processing apparatus as claimed in claim 1, wherein: said data part includes auxiliary information (col. 3, lines 50-55);

said auxiliary information indicates a position of the data part at a time of an initial display when the data part is initially displayed by the data processing part (fig. 3c and col. 11, lines 4-31); and

said data processing part displays the data part from the position indicated by the auxiliary information at the time of the initial display (fig. 3c and col. 11, lines 4-31).

As per claims 3 and 9,13 and 18, Powlette teaches the invention as shown in (fig. 1 and abstract) comprising:



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a developing part developing from an executable (fig. 3A-C; col. 5, lines 23-61 and col. 11, lines 4-31), a data processing part and a data part which is generated from by analyzing an input print job formed by a set of commands (col. 3, lines 39-56; col. 4, lines 11-40 and col. 11, lines 25-31), and is used by the, depending on an execute instruction; and updating part updating contents of the executable file using data modified by the developed data processing part (col. 3, lines 26-31 and col. 5, lines 23-49. see col. 10, lines 18-30 and col. 11, lines 25-31).

As per claims 4,10,14 and 19, Powlette teaches processing apparatus as claimed in claim 3, wherein: said data part include auxiliary information (fig. 3c; col. 5, lines 23-61 and col. 11, lines 4-31); said auxiliary information indicates a position of the data part at a time of an initial display when the data part is initially displayed by the data processing part (fig. 3c and col. 11, lines 4-31); and said data processing part displays the data part from the position indicated by the auxiliary information at the time of the initial display (fig. 3c and col. 11, lines 4-31).

As per claims 5,11 and 20, Powlette teaches the processing

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apparatus as claimed in claim 4, wherein said updating part updates the auxiliary information to a present display position of the data part depending on an end instruction (fig. 3c and col. 11, lines 4-31).

As per claims 6,12,15 and 21, Powlette teaches processing apparatus as claimed in claim 3, further comprising: a delete part deleting the developed data processing part and data part at an end of a process (col. 3, lines 50-56).

As per claims 7,16 and 17, Powlette teaches the invention for generating a file (fig. 1 and abstract), comprising:

data generating procedure for causing the computer to generate a data part generating by analyzing an input print job formed by set of commands (generates modified data based on the user's modifying of the initial data, performing annotations via a keyboard/mouse and generating additional data by an applet code in response to a user command from such input device, or some other authorized and accessible data source for the applet...a user is prompted to determine if they would like to capture and preserve the modified window image data, i.e. such as by printing in a hard copy form col. 4, lines 32-40 and col. 9, lines 2-34 and col. 10, lines 18-30) ( print commands must be

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analyzed to perform printing task. In order to print an image file, the right print driver must be loaded); and

file generating procedure for causing the computer to generate the executable file which includes the data part and a data processing part having as a processing target the data part developed depending on an execute instruction (col. 3, lines 39-56 and col. 4, lines 11-40),

said file generating procedure causing the computer to generate the executable file by including an updating part which updates contents of the file using data modified by the developed data processing part (col. 3, lines 26-31 and col. 5, lines 23-49).

As per claim 8, Powlette teaches the invention as claimed in claim 7, wherein:

said data part includes auxiliary information (col. 3, lines 50-55;

said auxiliary information indicates a position of the data part at a time of an initial display when the data part is initially displayed by the data processing part (fig. 3c and col. 11, lines 4-31); and

said data processing part displays the data part from the

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position indicated by the auxiliary information at the time of the initial display (fig. 3c and col. 11, lines 4-31).

### **Conclusion**

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Bargadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

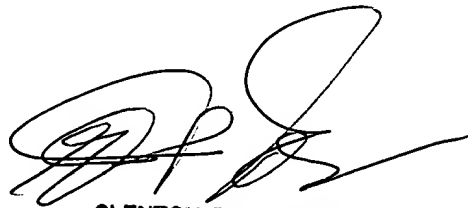
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may

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be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

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